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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,452

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Lutz Biedermann

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CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

01/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/660,452	Applicant(s) BIEDERMANN ET AL.	
	Examiner David H. Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,14-16,19,20 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,14-16,19,20,28,29,31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-7-08; 11-14-08</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3738

In the Information Disclosure Statements of November 7, 2008, and November 14, 2008, certain references were **not** considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) and/or a complete copy (37 C.F.R. § 1.98(a)(2)) was not presented. In the copies of DE 2 263 842 and WO 01/68003 A1, one of the pages is fragmented or incomplete.

Claim 30 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 10, 2006.

Claim 31 is objected to because of the following informalities: In claim 31, line 3, “or” should be replaced by --as--. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 15, second to last line, “the bore *of the intermediate elastic body*” (emphasis added) lacks a proper antecedent basis and renders the claim somewhat confusing as to the scope.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3738

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 14, 28, 29, 31, and 32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ferree, US 7,066,958 B2: Figure 28C; column 1, lines 55-58 and 61-64; column 2, lines 3-7; column 8, lines 48-49 and 59-62.

Claims 8, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferree, US 7,066,958 B2. The claimed plate and teeth configurations were well known in the art at the time of the present invention and would have been obvious to the ordinary practitioner in view of the teeth apparently illustrated in Figure 28C so as to provide a viable anchoring means into cortical bone. (It is also noted that the “cylindrical casing” is *not* a positively recited element of the prosthesis as set forth in present claims 19 and 20.)

Claims 7, 19, 20, 28, 29, 31, and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fleischmann et al., US 6,375,682 B1. Figures 1b, 2b, and 3, for example, illustrate top and bottom plates **12** and a core having curved surfaces defined by ball bearing members **44** and inner surfaces of radial bearing **24** (Figure 1c). The top and bottom plates have curved sections at the annular grooves **48** and at the hubs affixed by screws **50**. The annular intermediate body, comprising the bellows **26** and the plate **32**, provides elastic cushioning for the prosthesis (Figure 3; column 4, lines 50-58; column 7, lines 24-49; column 8, lines 5-10; etc.). The prosthesis can be configured to replace a natural vertebral disc (column 6, lines 6-9; column 3, lines 31-32; etc.). Regarding claim 32, the upper and lower bodies can alternatively

Art Unit: 3738

be equated with *only* the thrust bearing members **22** (and ball bearing members **44**), which do not extend into the bore of said elastic annular intermediate body.

Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischmann et al., US 6,375,682 B1. The further limitations of claim 8 would have been obvious for reasons presented above. Regarding claim 14, a mandrel would have been obvious in order to impose limits on the extent of relative rotations, with the ordinary practitioner having been impelled by the expressed need to reduce or eliminate the potential for damage to the spinal cord (column 4, lines 53-57) and other tissue.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Attention is directed to the abstract and to Figures 1, 4-6, and 8 of Main et al., US 4,932,975.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/David H. Willse/
Primary Examiner
Art Unit 3738**